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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,404	04/14/2005	Shuji Ichikawa	053466-0399	2536
22428	7590	11/28/2007		
FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			EXAMINER FAISON GEE, VERONICA FAYE	
			ART UNIT 1793	PAPER NUMBER
			MAIL DATE 11/28/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/528,404

Applicant(s)

ICHIKAWA ET AL.

Examiner

Veronica Faison-Gee

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

Claims 11-14 have been amended, no claims have been added and claims 1-10 canceled. Hence, claims 11-15 are pending in the application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ichikawa (US Patent 6,786,956) in view of Ikeda et al (US 2004/0207702).

Ichikawa teaches a ballpoint pen oil-based ink composition comprising an a colorant, an oil-based solvent, a mixture of at least one phosphoric acid ester, and at least one weakly cationic component selected from the group consisting of: imidazoline-type activator, polyoxyethylene alkylamine, polyoxyethylene alkylamide and alkylalkanolamide (abstract and col. 2 lines 15-23). The phosphoric acid ester is present in the amount of 0.1 to 15.0 percent by weight (col. 5 lines 35-36). The solvent present in the composition include alcohols, polyhydric alcohols and glycol ethers such as 3-methyl-1,3-butanediol, 1,3-butanediol, 3-methyl-3-methoxy-1-butanol, propylene glycol monomethyl ether (col. 6 lines 26+). The reference discloses in the examples that the solvents may be used in combination and that the solvents taught by the

reference include alcohol having an aromatic ring. A resin may be present in the composition in the amount of 1 to 30 percent by weight (col. 8 lines 28-30). The colorant present in the composition may be a dye or pigment, which may be present in the amount of 1 to 50 percent by weight (col. 8 lines 34-55). The reference further teaches that the ink composition may be used in a ballpoint pen, which may also include an ink follower (col. 9 lines 26-42). The reference fails to teach the specific formula set forth in claim 1.

Ikeda et al teaches an ink composition comprising amphoteric surfactants including amino acid types, carboxyammonium betaine types, sulfone ammonium betaine types, ammonium sulfate betaine types and imidazolium betaines.

Therefore it would have been obvious to one of ordinary skill in the art that any betaine type surfactant may be a replacement for an imidazolium betaine as shown by Ikeda et al.

### ***Response to Arguments***

Applicant's arguments filed 9-5-07 have been fully considered but they are not persuasive.

Applicant argues that although it has an earliest effective filing date of December 28, 2000 (effective filing date of its Japanese counterpart, which was published on July 19, 20002), US Patent 6,786,956 has the same inventor, Shuji Ichikawa of Japan, and is assigned to the same assignee, Mitsubishi Pencil Co., Ltd, as the present application.

The burden of establishing that subject matter is disqualified as prior art is placed on applicant once the Examiner has established a prima facie case of obviousness

based on the subject matter. For example, the fact that the reference and the application have the same assign is not, by itself, sufficient evidence to disqualify the prior art under 35 USC 103(c). ***There must be a statement that the common ownership was "at the time the invention was made."***

Applicant argues that US 2004/020772 is not qualified as prior art under 35 USC 102, because it has an earliest effective filing date of April 14, 2003, which is later than the earliest effective filing date of September 20, 2002 of the present application (effective filing date of its Japanese counterpart).

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

In response to applicant's argument that the means for solving the problem of blobbing with the combination of a phosphoric acid ester neutralized material with a certain substance, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. >See, e.g., *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed.Cir. 2006).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Veronica Faison-Gee whose telephone number is 571-272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

vfg  
11-26-07



J. A. DRENGO  
SUPERVISORY PATENT EXAMINER